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| 10/091,573 | 03/07/2002 | Carl Joseph Kraenzel | 23452-146 | 7969 |
| 909 | 7590 | 10/11/2006 | EXAMINER | |
| PILLSBURY WINTHROP SHAW PITTMAN, LLP | | | NGUYEN, TAN D | |
| P.O. BOX 10500 | | | ART UNIT | PAPER NUMBER |
| MCLEAN, VA 22102 | | | 3629 | |

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,573

Applicant(s)

KRAENZEL ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/25/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 4/25/02 was filed after the mailing date of the application on 3/7/02. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

2. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful (1) process, (2) machine, (3) manufacture, or (4) composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

3. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 13 is directed to a "computer signal" having certain characteristics. The signal of claim 13 is not recited to have any physical form, i.e., it is not expressly or impliedly an electrical or electromagnetic signal or a signal transmitted or stored in a physical medium. The signal could be a string of +1 and -1 sample values representing an encoded signal z, e.g. -1, +1, etc. for the encoded signal, but the representation of the signal is not claimed. Therefore, the claimed signal 13 is non-statutory subject matter because it's an abstract idea, and (2) it does not fall within one of the four categories of subject matter, (1) process, (2) machine, (3) manufacture, or (4) composition of matter, as cited above. The recited characteristics are a description of the signal itself and not a process that can be performed by a computer when imparted

Art Unit: 3629

with the requisite functionality. The signal claimed is a representation of an abstract idea. Furthermore, "A computer data signal" (or "1 signal" or "+1") can not represent a sequence of instructions (more than 1 signal) that when executed by one or more processors, causes the one or more processors to carry out the steps (a)-(c) as shown in the claim. Furthermore, "data signal embodied in a carrier wave" are not seen to be tangible, as they appear to be disembodied data.

Claim Objections

4. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how the computer signal further limits the steps, monitoring, determining and notifying, of method claim 1 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3629

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-13 (method), 14-25 (system), 26-37 (product) are rejected under 35 U.S.C. 103(a) as being unpatentable over TANG et al.

Claim 1 is as followed:

1. A computer implemented method, comprising the steps of:
 - monitoring the computing activities of a user of a computer;
 - determining if the computer user appears to be interested in a declared topic based on the monitored activities and based on information stored in a database that is associated with the declared topic; and
 - notifying the computer user that the topic has been declared if it appears that the computer user is interested in the declared topic.

Similarly, in a system/method for enabling awareness of others working on similar tasks in a computer working environment (collaborative computer system),

TANG et al discloses a computer implemented method, comprising the steps of:

(a) monitoring the computing activities of a user of a computer;

{see col. 3, lines 25-45, col. 5, lines 1-30, Fig. 7 ("145 Activity Monitor")}

(b) determining if the computer user appears to be interested in a declared topic based on the monitored activities and based on information stored in a database that is associated with the declared topic; and

{see col. 3, 50-55 "... determining task proximity between different users...", col. 5, lines 1-55}

(c.) notifying (informing) the computer user that the topic has been declared if it appears that the computer user is interested in the declared topic.

{see Fig. 1, element (20) "Encounter", Figs. 3, 4, col. 4, 30-50

"... for informing the current worker which other worker are task proximate ...",

col. 5, lines 1-65}. Note on col. 5, lines 1-67, TANG et al discloses various parameters for carrying out the step of determining if the user appears to be interested or task proximity such as the application (data), function (task) and time similarity (or constraint). Therefore, the selection of any of the determining variables or parameters, i.e. number of similar tasks or functions, would have been obvious to a skilled artisan as mere routine experimentations since this depends on degree of accuracy or effectiveness of the task proximity or related determination.

Art Unit: 3629

As for dep. claims 2-7, 10 (part of 1 above), which deals with well known monitoring user activities (profiles/information/data) parameters, i.e. messages including e-mails, instant messages, etc., the monitoring and tracking of user data (accessing/retrieving) is taught in col. 3, lines 25-30 " ... *type of work they are doing, such as the data they are accessing.*", col. 5, lines 25-30 "... *accessing the same web page or email message ...*". Col. 5, lines 45-65 and col. 6, lines 50-57. TANG et al fairly teaches the concept of content extraction to determine task proximity. Therefore, it would have been obvious to apply the same data content extraction method to other communication data such as e-mails, instant messages, etc. as mere using other similar user information /data.

As for dep. claims 8-9, 11-12 (part of 1 above), which deals with steps (b) determining proximity/interested level parameters and (c) notifying others parameters, These parameters are fairly taught in col. 6, line 22 to col. 7 line 35, Fig. 2 (20), Figs. 3-4, Fig. 5a/5b (18) "Mode of awareness", Fig. 9. "Level of activity". The use of other similar determining or notifying parameters would have been obvious to a skilled artisan as routine experimentations to determine effective results for various applications.

As for dep. claim 13 (part of 1 above), which deals with the computer signal for carrying out the method of claim 1 above, it's rejected over the computer signal of TANG et al for carrying out the method of claim 1 as rejected above.

As for independent system claim 14, which is the system to carry out the method of independent method claim 1 above, it's rejected over the system of TANG et al in order to carry out the method as rejected in claim 1 above. Alternatively, it would

Art Unit: 3629

have been obvious to a skilled artisan to set up a system in TANG et al to carry out the steps in the rejection of claim 1 above.

As for dep. claims 15-25 (part of 14 above), which have similar limitation as in dep. claims 2-12 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 2-12 above.

As for independent product claim 26, which is the computer program product being embodied in a computer readable medium and comprising the computer instructions for carry out the method of independent method claim 1 above, it's rejected over the computer program product of TANG et al to carry out the method as rejected in claim 1 above. Alternatively, it would have been obvious to a skilled artisan to set up a computer program product in TANG et al to carry out the steps in the rejection of claim 1 above.

As for dep. claims 27-37 (part of 26 above), which have similar limitation as in dep. claims 2-12 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 2-12 above.

Conclusion

9. US 6,317,722, Jacobi et al., is cited to teach well known steps of monitoring user profiles contained in database to make recommendations for items of interest on the Internet.

Art Unit: 3629

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
September 29, 2006



DEANT.NGUYEN
PRIMARY EXAMINER